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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,281	08/07/2001	Geoffrey B. Rhoads	P0414	5601
23735	7590	06/14/2006	EXAMINER	
DIGIMARC CORPORATION			SAM, PHIRIN	
9405 SW GEMINI DRIVE			ART UNIT	PAPER NUMBER
BEAVERTON, OR 97008			2616	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/924,281

**Applicant(s)**

RHOADS, GEOFFREY B.

**Examiner**

Phirin Sam

**Art Unit**

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



**PHIRIN SAM**  
**PRIMARY EXAMINER**

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding “discourage piracy”, these limitations do not disclose in the specification.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,822,360 (hereinafter referred as “Lee”) in view of US Patent 5,612,974 (hereinafter referred as “Astrachan”).

Lee discloses the invention (**claims 1, 3, and 4**) as claimed including, in a cellular telephone including a microphone, a modulator, an antenna, and an RF amplifier, the device serving to receive audio and transmit an RF signal conveying audio modulation, an improvement comprising:

- (a) a steganographic encoder for hiding plural bits of auxiliary data within the audio modulation of said RF signal (see Fig. 1, col. 7, lines 65-67, and col. 8, lines 1-9, 56-67);

Lee does not disclose a cellular telephone including a microphone, a modulator, an antenna, and an RF amplifier. However, Astrachan discloses the cellular telephone including the microphone, the modulator, the antenna, and the RF amplifier (see Fig. 1, col. 4, lines 29-41). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine a cellular telephone including a microphone, a modulator, an antenna, and an RF amplifier teaching by Astrachan with Lee. The motivation for doing so would have been to provide a single IC that performs cellular telephone features while more readily accommodating the consumer requirements of lighter weight, smaller packages, and longer talk time read on column 2, lines 58-61. Therefore, it would have been obvious to combine Astrachan and Lee to obtain the invention as specified in the claim 1.

**Regarding claims 5-7,** Lee discloses, in a battery-powered wireless reception device sized for fitting in a user's pocket or purse, the device including an RF amplifier, an antenna, a demodulator, and a speaker, the device serving to receive RF transmissions and output an audio signal conveyed thereby, an improvement comprising:

- (a) a steganographic decoder for discerning multi-symbol auxiliary data conveyed as slight alterations to said audio signal (see Fig. 1, element 26, col. 8, lines 19-26);

Lee does not disclose an RF amplifier, an antenna, a demodulator, and a speaker. However, Astrachan discloses the RF amplifier, the antenna, the demodulator, and the speaker (see Fig. 1, col. 4, lines 29-41, wherein the device fits in a user's pocket or purse is a design choice and nowadays, the cell phone or pager is getting smaller and smaller. Therefore, two or three cell phones or pagers can fit in pocket or purse. It is obvious). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the RF amplifier,

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the antenna, the demodulator, and the speaker teaching by Astrachan with Lee. The motivation for doing so would have been to provide a single IC that performs cellular telephone features while more readily accommodating the consumer requirements of lighter weight, smaller packages, and longer talk time read on column 2, lines 58-61. Therefore, it would have been obvious to combine Astrachan and Lee to obtain the invention as specified in the claims 5-7.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 3, and 4 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) US Patent 5,696,789 (Jones et al) discloses apparatus and method for signal identification.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on a compress schedule, from 8:00-5:30, first Wed off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272 - 3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully submitted,

Date: June 7, 2006

A handwritten signature in black ink, appearing to read 'Phirin', written over a horizontal line.

**PHIRIN SAM  
PRIMARY EXAMINER**